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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/662,195	09/14/2000	Keith H. Johnson	2000200-0003	2403

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EXAMINER

GOLLAMUDI, SHARMILA S

ART UNIT	PAPER NUMBER
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1616

DATE MAILED: 08/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action Before the Filing of an Appeal Brief	Application No. 09/662,195	Applicant(s) JOHNSON, KEITH H.	
	Examiner Sharmila S. Gollamudi	Art Unit 1616	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 07 July 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
 b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☒ The Notice of Appeal was filed on 07 July 2005. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
 (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
 (b) ☐ They raise the issue of new matter (see NOTE below);
 (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
 5. ☐ Applicant's reply has overcome the following rejection(s): _____.
 6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
 7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
 The status of the claim(s) is (or will be) as follows:
 Claim(s) allowed: _____.
 Claim(s) objected to: _____.
 Claim(s) rejected: _____.
 Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
 10. ☒ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached sheet.
 12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
 13. ☐ Other: _____.

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Applicant argues that the examiner has improperly made the Office action of 6/8/05 Final.

Applicant's arguments are found not to be persuasive. As applicant is well aware of, the examiner may make an action final if applicant makes any amendments made to claims that requires a new search and citation of new prior art. Note MPEP 706.7(a): "Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p). In instant case, applicant changed the scope of the claims to "nanoemulsion" to overcome the prior art since the prior art taught emulsions but did not specify a nanoemulsion. Secondly, applicant amended independent claim 11 and 26 not only to recite nanoemulsion but also added "wherein said oil formulation is selected from the group consisting of cosmetic and pharmaceutical oil" to overcome the 102 rejection over Johnson et al. It should be noted that claim 11 did not have this limitation in a dependent claim. As applicant is well aware, if applicant's amendments require the citation of new art, then the examiner has the right to go final. Further, applicant is mistaken in that the examiner can only go final if the applicant has added new claims. The examiner suggests reading MPEP 706.7. Thus, it is the examiner's position that the action was properly made final.

Applicant argues that Roessler et al do not disclose a specific amount of water or oil and discloses several surfactants.

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Applicant's arguments are found not to be persuasive. The examiner points out that the independent claim 1 and 25 only require at least 5% water and does not recite a specific concentration of oil. Independent claim 11 and 26 and dependent claim 8 require 5-50% water and 10-90% oil. The examiner points out that Roessler teaches 0.1-35% water and 0.1-95% oil which clearly fall within the instant range. Applicant claims 5-50% surfactants from the group consisting of fatty acids, ethoxylates, and alcohols. The examiner points out that Roessler teaches 10-45% surfactants, which falls within applicant's range. It is further pointed out that although applicant argues that a specific selection of surfactants provide for the instant water cluster, the surfactants claimed are a broad and encompass a broad range of surfactants. For instance, Table 1 of Roessler discloses fatty acid surfactants, ethoxylated surfactants, and alcohol surfactants. It should be noted that majority of the surfactants fall within applicant's claimed Markush group. For instance, all the POE surfactants of Table 1 are encompassed by applicant's ethoxylated surfactants, all the surfactants containing fatty acids of any form, for instant Roessler's oleic acid, are encompassed by applicant's fatty acid surfactants, etc. Thus, applicant's arguments asserting that Roessler does not teach the instant surfactants are perplexing. Moreover, the prior art utilizes TWEEN 80 in the examples, which is an ethoxylated surfactant, and the instant amount of oil and water. See Table 2-3.

Applicant argues that Roessler does not teach the desired effect of nanoclustered water.

Applicant's arguments are found not to be persuasive. The examiner points out that the prior art does not have to recognize an inherent feature, i.e. that the water forms nanoclusters, or the "desired effect" it imputes. "There is no requirement that a person of ordinary skill in the art would have recognized the inherent disclosure at the time of invention, **but only that the**

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subject matter is in fact inherent in the prior art reference.” See *Schering Corp. v. Geneva Pharm. Inc.*, 339 F.3d 1373, 1377, 67 USPQ2d 1664, 1668 (Fed. Cir. 2003). It is noted that applicant does not dispute the examiner’s position that the instant surfactants provide the instant nanoclusters, in fact applicant acknowledges this fact. See page 3 of the response. Therefore, since the prior art teaches the same water-in-oil nanoemulsions with the same amount of water, oil, and surfactant, the dimensions of the water cluster will be the same as claimed by the instant invention. Claiming a new use, new function, or unknown property which is inherently present in the prior art does not make the claim patentable. In *re Best*, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977). See also MPEP § 2112.01 with regard to inherency.

Applicant argues that Roessler does not constitute art and the citation of MPEP 901.02.

The examiner points to the new 102(e) in MPEP 2136:

“Revised 35 U.S.C. 102(e), as amended by the American Inventors Protection Act of 1999 (AIPA) (Pub. L. 106-113, 113 Stat. 1501 (1999)), and as further amended by the Intellectual Property and High Technology Technical Amendments Act of 2002 (Pub. L. 107-273, 116 Stat. 1758 (2002)), applies in the examination of all applications, whenever filed, and the reexamination of, or other proceedings to contest, all patents. Thus, the **filing date of the application being examined is no longer relevant in determining what version of 35 U.S.C. 102(e) to apply in determining the patentability of that application, or the patent resulting from that application.** The revised statutory provisions supercede all previous versions of 35 U.S.C. 102(e) and 374, with only one exception, which is when the potential reference is based on an international application filed prior to November 29, 2000 (discussed further below). The provisions amending 35 U.S.C. 102(e) and 374 in Pub. L. 107-273 are completely retroactive to the effective date of the relevant provisions in the AIPA (November 29, 2000). Revised 35 U.S.C. 102(e) allows the use of certain international application publications and U.S. patent application publications, and certain U.S. patents as prior art under 35 U.S.C. 102(e) as of their respective U.S. filing dates, including certain international filing dates. The prior art date of a reference under 35 U.S.C. 102(e) may be the international filing date if the international filing date was on or after November 29, 2000, the international application designated the United States, and the international application was published by the World Intellectual Property Organization (WIPO) under the Patent Cooperation Treaty (PCT) Article 21(2) in the English language. See MPEP § 706.02(f)(1) for examination guidelines on the application of 35 U.S.C. 102(e).

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The examiner also points out that MPEP 800 and 900 with regard to 102(e) have not been revised as noted in the Blue Pages:

It is noted that the discussion of 35 U.S.C. 102(e) in Chapters 800 and 900 has not yet been updated to incorporate revised 35 U.S.C. 102(e) (as amended by the Intellectual Property and High Technology Technical Amendments Act of 2002). When using Chapters 800 and 900 where 35 U.S.C. 102(e) has not yet been updated, users of the **Manual should refer to Chapters 700 and 2100 for the revised 35 U.S.C. 102(e)** as amended by the Intellectual Property and High Technology Technical Amendments Act of 2002.

Therefore, Roessler constitutes prior art under 102 (e).

Applicant argues that Ying's trimethylpentane is a hydrocarbon oil that is not used in the cosmetic or pharmaceutical art. Applicant argues that applicant's arguments pertaining to inherency are unfounded. Applicant argues that Ying does not teach the composition or process.

Applicant's arguments are found not to be persuasive. Firstly, the examiner points out that only the composition claims are rejected, thus applicant's argument that Ying does not teach the process are moot. Secondly, it is pointed out that the examiner has provided a detailed rationale for inherency in the Final Office Action. As noted in MPEP 2112, the burden shifts to the applicant to provide evidence (not an opinion) to dispute the examiner's position. It is noted that several times, applicant has acknowledged that the surfactants provide for the instant nanoclusters. Further, applicant asserts that the also the oil and water concentration are critical; the examiner points out that Ying's components and concentrations are identical to the instantly claimed compositions. Lastly, the examiner cites US 6,139,823 as art of interest. US '823 is directed to transfer resistant **cosmetic** compositions wherein the art teaches the use of hydrocarbon oils such as instantly disputed trimethylpentane as carriers (in the same


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concentration as applicant) for the composition. See column 8, lines 60-65. Other art of interest can be supplied to demonstrate the conventional use of trimethylpentane in the cosmetic art.

Lastly, with regard to applicant's Rule 132 declaration, the examiner points out that a Rule 132 declaration does not overcome a rejection based on anticipation. It is further noted that applicant's Rule 132 declaration is an **opinion** declaration without any factual basis or data. For instance, applicant states that "Roessler et al discloses a broad array of nanoemulsions....**which could** result in varying significantly structural forms of water" Thus, it is noted that applicant does not provide data that disputes the examiner's position. Furthermore, applicant is ambiguous on whether the prior art does or does not form the nanoclusters as accorded by the phrase" which could".

With regard to Ying, the only evidence applicant provides the nanoclusters are not inherent is the opinion that Ying's trimethylpentane is not a cosmetic or pharmaceutical oil, Firstly, this is not evidence showing that the nanoclusters are not inherently formed, this is just an argument disputing the examiner's position that the prior art's trimethylpentane reads on the instant "cosmetic or pharmaceutical oil". The type of oil will not effect if the nanoclusters are formed or not since clearly US 5,800,576 demonstrates that a surfactant, water, and fuel (a hydrocarbon oil) provides the instant water nanocluster dimensions. Furthermore, the examiner has already pointed out that the cosmetic art clearly utilizes trimethylpentane in applicant's instantly claimed concentration for topical application. Therefore, the Rule 132 does not rebut the examiner's position of inherency.

Accordingly, all the rejections are maintained.


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